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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,831	03/09/2001	Andrew McGrath	40736	5700

7590 09/25/2003
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EXAMINER

DIAMOND, ALAN D

ART UNIT PAPER NUMBER

1753

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,831

Applicant(s)

MCGRATH ET AL.

Examiner

Alan Diamond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it is too long. The abstract should be 150 words or less. Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claims 1 and 33 are objected to because of the following informalities: In claim 1, at line 13, the word "and" should be inserted after "assembly;". In claim 33, at line 1, the term "in to" should be changed to "into". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14, 31, 32, 34-37, and 41-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, at the last line, the term "said respective gel tubes" should be changed to "said respective gel tube" so as to clearly point out that the sample is transferred to the respective gel tube. The same applies to dependent claims 2-14.

Claim 5 is indefinite because "said sample magazine" at line 2 lacks positive antecedent support in claim 5. It is suggested that "sample" at line 2 be changed to "supply".

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Claim 10 is indefinite because "said cover members" at lines 4-5 lacks positive antecedent support in claim 9. It is suggested that "member" be deleted from line 5 of claim 10.

In claim 12, at line 7, it is not clear which end is being referred to by the term "a second end". It is suggested that said term be changed to "said second end" since claim 1 sets forth a second open end for the gel tubes. The same applies to dependent claim 13.

In claim 14, at each of lines 7 and 8, the term "cover" should be changed to "cover member" so as to be consistent with the cover member that is previously recited in claim 14.

Claim 31 is indefinite because "said stop members" at line 6 lack positive antecedent support in claim 30. It is suggested that "members" be changed to "member" at line 6 of claim 31.

In claim 32, at line 7, the term "cover" should be changed to "cover member" so as to be consistent with the cover member that is previously recited in claim 32.

Claim 34 is indefinite because "said assembly" at lines 2-3 lacks positive antecedent support in claim 33. The same applies to dependent claims 35, 36, and 41-45.

Claim 37 is indefinite because "said gel tubes" at line 5 lack positive antecedent support in claim 33.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-76 of U.S. Patent No. 6,537,434. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rack that is present in the automated first dimensional electrophoresis apparatus in claim 1 of said patent is not excluded from the automated first dimensional electrophoresis apparatus in instant claim 1. The rack that is present in the automated electrophoresis apparatus in claim 31 of said patent is not excluded from the automated first dimensional electrophoresis apparatus in instant claim 15. Furthermore, the rack that is present in the claims of said patent are not excluded from the apparatus of instant claim 33.

Conclusion


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patents 4,909,920 and 5,356,525 are hereby made of record. Also made of record are U.S. Patent Application Publications 2002/0108857, 2002/0146832, and 2002/0151076.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is 703-308-0840. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 703-308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in cursive script, appearing to read "Alan Diamond".

Alan Diamond
Primary Examiner
Art Unit 1753

Alan Diamond
September 8, 2003